

REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1, 2, 4-12 and 17-20 are all the claims pending in the application.

Claim Rejections - 35 USC § 103

Claim 1, 2 and 4-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Toy et al. (US Pat. No. 6,192,115; hereinafter “Toy”) in view of Koster (US Pat. No. 6,259,914) further in view of Scalisi et al. (US Pat. No. 7,005,963; hereinafter “Scalisi”).

Independent claim 1 recites, in part:

a mode changing unit that changes a mode of a connection between said caller terminal and said mobile station from a conversation mode to a text-based mail sending mode upon receiving a request from said caller terminal,

wherein after the retaining unit temporarily retains establishing the connection between said caller terminal and said mobile station, said mode changing unit changes from the conversation mode to the text-based mail sending mode upon receiving the request from said caller terminal, the notification system allows said caller terminal to write and send a text-based mail message to said mobile station[.]

The Examiner admits that the combination of Toy and Koster fail to teach or suggest these claimed features.¹ However, the Examiner asserts that Scalisi cures this deficiency of Toy and Koster. Applicant submits the Examiner's reliance on Scalisi is misplaced.

Applicant notes that Scalisi simply describes a method of storing, retrieving and recalling calls to a call receiving pager apparatus or pagephone made by outside callers. An outside caller makes a call to the pagephone in step 700 and the outside caller's telephone number is displayed on the pagephone's LCD in step 702. Once the pagephone subscriber has had a chance to view the telephone number and identity of the caller, the pagephone subscriber elects whether or not to accept the call in step 704.² If the subscriber elects not to accept the call in step 704, one of the options the caller has is to leave a text message if the outside caller is calling from a communication device which allows for the creation of text messages.³ Thus, in Scalisi, the caller is only presented with the option of leaving a text message if the subscriber elects not to accept the call.

In other words, in Scalisi, since the subscriber decides whether or not to accept the call, there is no mode changing unit which changes from the conversation mode to the text-based mail sending mode after a retaining unit temporarily retains establishing the connection between said

¹ Applicant notes that in the fourth paragraph on page 4 of the current Office Action, the Examiner misquotes the language of the claim, and mistakenly refers to the claim language prior to the previous amendment filed on September 13, 2007. However, in the paragraph bridging pages 4 and 5 of the current Office Action, the Examiner appears to have correctly addressed the claim as amended in the amendment filed on September 13, 2007.

² See Scalisi, col. 23, line 61 to col. 23, line 2.

³ See Scalisi, col. 24, lines 13-15.

caller terminal and said mobile station. Consequently, Applicant submits that Scalisi fails to teach or suggest wherein after the retaining unit temporarily retains establishing the connection between said caller terminal and said mobile station, said mode changing unit changes from the conversation mode to the text-based mail sending mode upon receiving the request from said caller terminal, the notification system allows said caller terminal to write and send a text-based mail message to said mobile station, as claim 1 requires. Indeed, Applicant submits that none of the cited references, either alone or in combination, teaches or suggests these unique features of the claimed invention.

Nevertheless, the Examiner goes on to conclude:

[i]t would have been obvious to one ordinarily skilled in the art at the time of invention to be able to send text-base messages instead of talking to the called party if parties are not simultaneously available.

Applicant respectfully disagrees.

Even assuming, *arguendo*, that the combination of cited references discloses all of the above-noted claimed features, Applicant submits that one of ordinary skill in the art would not have been motivated to combine the references as the Examiner suggests, since there are well-known alternatives to talking to a called party if parties are not simultaneously available. For example, a calling party could simply leave a voicemail message if the called party is not available. Thus, it would not necessarily have been obvious to one of ordinary skill in the art, at the time of invention, to send text-base messages instead of talking to the called party if parties

are not simultaneously available. Instead, Applicant submits the Examiner's conclusion is entirely based upon improper hindsight reasoning.

Furthermore, Applicant submits that if one were to modify Toy as the Examiner suggests, a substantial modification would be required. The whole idea behind Toy is to provide the calling party with information about the called party so that the calling party can decide whether to complete the call.⁴ In particular, in the system of Toy, the calling party receives information concerning the charges to be incurred in making a call to the called party.⁵ If the calling party decided that the call was going to be too expensive, there would be no reason for him to decide to leave a text message instead, since doing so would inevitably incur an additional cost, thus defeating the purpose of deferring the communication with the called party. Consequently, the principle of operation of Toy would be impermissibly altered.⁶

Moreover, even if leaving a text message did not incur extra cost for the calling party, the entire structure of Toy would have to be altered to accommodate the ability to leave a text message. As shown in FIG. 2 of Toy, if the caller has not requested call completion in step 215, the call is simply abandoned in step 219. In order to allow the caller the option of leaving a text message, new hardware and a complete new set of operations would have to be incorporated into

⁴ See Toy, Abstract.

⁵ *Id.*

⁶ See MPEP §2143.01(VI)

the system and method of Toy. As a result, the call could not simply be completed or abandoned as FIG. 2 shows. Again, the principle of operation of Toy would be impermissibly altered.²

Accordingly, Applicant submits that independent claim 1 is patentable over the prior art of record for at least these reasons stated above. Further, Applicant submits that dependent claims 2 and 4-8 are patentable, at least by virtue of their respective dependency on independent claim 1.

Claim 9 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Toy in view of Koster further in view of Scalisi in further view of Dunn et al. (US Pat. No. 6,138,008; hereinafter “Dunn”). Claim 11 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Toy in view of Koster further in view of Scalisi in further view of Asano et al. (US Pat. No. 5,991,721; hereinafter “Asano”). Claim 17-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Koster in view of Frey et al. (US Pat. No. 6,535,596; hereinafter “Frey”) further in view of Scalisi.

Applicant submits that none of the applied references, or any combination thereof, cures the deficiencies noted above regarding independent claim 1. Thus, Applicant submits that independent claim 17 is patentable for reasons analogous to those stated above regarding independent claim 1. Further, Applicant submits that dependent claims 9-12 and 18-20 are patentable over the prior art of record, at least by virtue of their respective dependency on independent claims 1 and 17.

² See MPEP §2143.01(VI)

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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